In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 413

SHELDON L. POLLACK and MAX E. ADAMS,
PETITIONERS

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

The opinion of the district court (J.A. 36-43)[1] is reported at 229 F. Supp. 405.[2] The opinion of the

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[1] "J.A." refers to the Joint Appendix in the court of appeals.

[2] The brief oral opinion of the district court, set forth in Appendix A to the petition, was supplemented by a written opinion, referred to in the text.

court of appeals (Pet. App. 2-3) is reported at 346 F. 2d 799.

JURISDICTION

The judgment of the court of appeals was entered on April 8, 1965. The time for filing a petition for a writ of certiorari was extended on July 1, 1965, by order of Mr. Justice Goldberg to and including August 1, 1965. The petition for a writ of certiorari was filed on July 31, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether the court of appeals erred in sustaining the district court's finding that petitioners' patent application did not exhibit a sufficient advance over the prior art to require issuance of a patent.

2. Whether, in a suit under 35 U.S.C. 145 to review the Patent Office's denial of a patent application, it is proper for the district court to accord presumptive validity to the decision of the Patent Office.

STATUTE INVOLVED

35 U.S.C. 145 provides in relevant part as follows:

> An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia * * *. The court may adjudge that such applicant is

entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. * * *

STATEMENT

In this action under 35 U.S.C. 145, petitioners sought review of the decision of the Patent Office denying their application for a patent relating to a reinforced masonry wall. Both the Patent Office Examiner (J.A. 161-71) and the Patent Office Board of Appeals (J.A. 172-8) had held petitioners' claims unpatentable on the ground that, in view of the prior art, the substance of the claims would be obvious to any person having ordinary skill in the art.[3]

Petitioners' application (J.A. 123-136C) disclosed a masonry wall built of units consisting of two parallel bricks joined by two metal rods having their ends embedded in the bricks. These units are stacked about previously erected reinforcing steel (J.A. 136A, Fig. 2). The space between the two brick walls is then filled with grout (a type of mortar),[4] which embeds the

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[3] See 35 U.S.C. 103: "A patent may not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * * *"

[4] "Grout" is defined as a "thin mortar fluid enough to be poured and used for filling in spaces (as the joints of masonry,

reinforcing steel (J.A. 136C, Fig. 5) and makes the wall monolithic.

Petitioners' application admitted the existence of prior art for making reinforced masonry walls under which "the bricks are laid separately on each side of reinforcing steel which is spaced therebetween. The grout is poured between the bricks to embed the reinforcing steel and to fill the space" (J.A. 124). The application states, however, that some building codes prohibited the pouring of grout in the prior art wall to a height of more than one brick at any one time. The application explained that, where there is nothing to hold the bricks together, the grout pressure will tend to push the bricks apart if the grout level is too high (J.A. 125). Petitioners' method makes it possible under these building codes to pour grout for many levels of brick at one time, since the metal rods embedded in the brick hold the two walls together (J.A. 129).

Investigation of the prior art revealed three prior patents for reinforced masonry walls in which two parallel brick walls are joined by rods or other connecting elements, the space between the walls being either left hollow or filled with grout—the Hild patent (J.A. 195J, 195K), the Betzler patent (J.A. 195D), and the Simms patent (J.A. 195L). There was evidence that petitioners' wall had achieved considerable commercial success and that the walls disclosed in the prior patents had not (J.A. 72-79, 80-87, 90, 97, 100, 155-56, 179-182G, 185-194).

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brickwork * * *)." Webster's *Third New International Dictionary.*

The district court held that petitioners had not overcome the "presumption of validity attaching to Patent Office adjudications" (J.A. 43). The court relied primarily on the prior art disclosed in the Hild patent (J.A. 42):

> Utilizing spaced two-brick units to build high walls on either side of vertical reinforcement members is clearly shown by Hild * * *. Pouring grout between the sides of spaced brick walls was admitted to be conventional * * *. Since both of these teachings were quite common in the art at the time of the invention, it does not appear to the Court that to combine them would have been more than an obvious expedient within the province of mechanical skill.[5]

As to the evidence of commercial success, the court stated that "[s]uch evidence must be considered immaterial * * * when invention is lacking" (J.A. 42).

The court of appeals affirmed on the basis of its "examination of the entire record" (Pet. App. 3). Conceding that petitioners "taught an improved method" and that "the evidence showed a high degree of commercial success," it stated (Pet. App. 3):

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[5] The district court held alternatively that "each of the claims is directly readable on the grout-filled foundation wall embodiment of Hild. That embodiment shows a monolithic wall construction made up of basic two brick units identical to plaintiffs' which are stacked on either side of vertical reinforcing members. After the bricks are stacked three or more layers high, the space between them is filled with grout. * * * [I]t seems to the Court that the solid foundation wall of the Hild patent is in all essential respects identical to the subject matter of plaintiffs' claims" (J.A. 41).

Important though such factors may be in a close case, of themselves they do not establish patentability. The trial judge reasonably could have concluded that there simply was an inadequate showing of invention.

ARGUMENT

1. Two administrative tribunals and two courts have held that the prior art precludes issuance of a patent to petitioners. The correctness of this decision cannot seriously be disputed. Petitioners' only contention with respect to the Hild patent—the principal item of the prior art—rests on a factual error, pointed out by the district court, as to the scope of the Hild patent.[6] Petitioners' failure to show a patentable advance over the prior art cannot be remedied by evidence of commercial success: "commercial success without invention will not make patentability." *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147, 153.

2. The decision of this Court in *Morgan* v. *Daniels*, 153 U.S. 120, required the courts below to accord a presumption of validity to the Patent Office decision.

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[6] The district court stated (J.A. 42):

> The plaintiffs have contended that since the interior of Hild's *hollow* wall embodiment is coated to prevent corrosion, a person skilled in the art would not be taught to fill it with grout. This contention is effectively rebutted by the presence, in the very same disclosure, of a similar but non-coated *solid* wall embodiment which *is* filled with grout. It is further rebutted, of course, by the secondary references which show that to fill spaced brick walls with grout is common in the art." (Emphasis in original.)

Compare Pet. 13.

In that case, decided under Rev. Stat. 4915, the predecessor to 35 U.S.C. 145,[7] this Court held that the decision of the Patent Office must be accepted as controlling "unless the contrary is established by testimony which in character and amount carries thorough conviction." 153 U.S. at 125. This holding has been consistently followed. *E.g.*, *Gold* v. *Newton*, 254 Fed. 824, 827-828 (C.A. 2), certiorari denied, 249 U.S. 608; *Fletcher* v. *Watson*, 204 F. 2d 68, 69 (C.A.D.C.); *Abbott* v. *Coe*, 109 F. 2d 449, 451 (C.A.D.C.). The presumption has been held inapplicable only where the trial *de novo* in the district court reveals facts that were not before the Patent Office. *Stradar* v. *Watson*, 244 F. 2d 737, 739 (C.A.D.C.); cf. *Dresser Industries* v. *Smith-Blair, Inc.*, 322 F. 2d 878, 888 (C.A. 9). Here the full factual situation was disclosed in the evidence before the Patent Office, which included evidence of the commercial success of petitioners' wall—the fact on which petitioners principally relied in the district court (J.A. 155-56, 166, 177). There was no additional evidence before the district court requiring rejection of the administrative finding of no patentable advance over prior art.

Petitioners' complaint that they were denied the right of cross examination has no merit. The district court did not rely on any extra-record evidence; it simply held that petitioners had failed to discharge

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[7] While there are many differences in language between Rev. Stat. 4915 and 35 U.S.C. 145, the language that is crucial here—requiring the court reviewing the Patent Office decision to decide "as the facts in the case may appear"—is identical.

their burden of proving the administrative decision wrong.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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REPLY TO OPPOSITION OF GOVERNMENT TO PETITION FOR WRIT OF CERTIORARI

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Come now Sheldon L. Pollack and Max E. Adams and reply to the opposition of the government to their petition for writ of certiorari as follows:

The government has abbreviated our questions incorrectly and reduced them to two. It has therefore not answered them. It has not fully set forth the questions we have specifically raised, which are of great importance not only in the patent world but in the construction of Title 35, Section 145(c), U.S. Codes, and particularly the words "trial de novo", not contained in Section 4915 of U.S. Codes.

The question here is this: Not only did the District Court err in holding that the case was governed by the